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Paper No. 15

In re Application of
Raymond C. McGarvey
Serial No. 07/937,560
Filed: August 31, 1992
For: MINIMUM DEAD
VOLUME FITTING

:
: DECISION ON PETITION
: REGARDING REQUIREMENT
: FOR RESTRICTION

Applicant's petition, filed June 24, 1994, requests that the examiner be directed to act on the merits of certain claims which presently stand withdrawn under 37 CFR 1.142(b) as being directed to non-elected species.

The petition is DISMISSED, with instructions to the examiner.

A review of the record shows that the examiner considered that, as filed, there were claims directed to several distinct species of the generic invention, and required applicant to elect a single species for prosecution on the merits in this application.¹ Applicant, in response to the election requirement, elected a single species and identified the claims which applicant regarded as being readable on the elected species.² In the next Office letter³, the examiner took issue with the claims identified by applicant as being readable on the elected species, and withdrew claims 1-18 and 22 from consideration pursuant to 37 CFR 1.142(b). Throughout the subsequent prosecution of the application, the examiner and applicant have disagreed concerning whether certain claims were readable on the elected species. Applicant has continued to argue that the claims in fact read on the elected species, while the examiner has continued to treat the claims as withdrawn. Concurrently with this petition, applicant filed a Notice of Appeal⁴ and the fee therefor.⁵ The Notice of Appeal identifies only claims 19, 20 and 23 as subject to the appeal. These are the sole claims identified as being unpatentable, with claim 21 being identified as

¹See paper No. 3, dated July 6, 1993 and MPEP § 809.02(a).

²See paper No. 5, filed July 21, 1993 and MPEP § 809.02(a).

³Paper No. 6, dated September 2, 1993

⁴35 USC 134; 37 CFR 1.191

⁵37 CFR 1.17(e)

being allowable and claims 1-18 and 22 remaining withdrawn.⁶

The question of whether any requirement for restriction is proper, including an election of species requirement, is petitionable.⁷ Applicant has not, however, contested the propriety of the requirement to elect species. That is, applicant has never argued that the requirement made in paper No. 3 was erroneous, or that the species as identified by the examiner are not patentably distinct. Applicant has merely argued that certain claims which have been withdrawn from consideration actually are readable on the elected species. However, the question of whether certain claims do or do not read on an elected invention, including an elected species, is not a matter which is petitionable under 37 CFR 1.144 or 37 CFR 1.181. Rather, this question is an issue which is appealable.⁸ However, the examiner has never rejected any of the claims so withdrawn, but has been content merely with applying 37 CFR 1.142(b).

Because the question of whether the claims in dispute do or do not read on the elected species is one which is outside of the jurisdiction conferred by 37 CFR 1.144 and 1.181, the instant petition must be dismissed. However, applicant would then have no remedy with respect to this issue. Therefore, the examiner is instructed to withdraw the final action dated March 18, 1994 and to issue a new action treating claims 1-18 and 22 in accordance with MPEP § 821. This action should treat the amendment filed June 16, 1994 as having been entered, and may properly be made final⁹ inasmuch as the issue which would become the subject of any rejection made in accordance with MPEP § 821

⁶See paper No. 13, dated July 6, 1994 and paper No. 10, dated March 18, 1994.

⁷37 CFR 1.144; MPEP § 1002.02(c)(3)

⁸See MPEP § 821

⁹MPEP 706.07(a)

has repeatedly been raised throughout prosecution¹⁰ and appears ripe for final action. The application is being forwarded to the examiner for action in accordance with this decision.

PETITION DISMISSED.



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¹⁰See, for example, paper Nos. 5, 6, 9 and 10.